

REMARKS

Claims in the Application. Claims 23 and 37 have been amended. Claims 23-27 and 37-38 and 40 are active in this application. Reconsideration is respectfully requested.

Request to Withdraw the Finality of the Rejection. The Examiner is requested to *withdraw* the finality of the rejection. The Examiner has applied a new ground of rejection in the Office Action. See PTO-892 form attached to the Office Action. U.S. Patent No. 6,153,674 ("*Landin*") was not previously cited by the Examiner. Thus, the rejection of the claims under U.S. Patent No. 4,293,173 ("*Tricca*") in view of *Landin* is a new ground of rejection. The amendment to the claims in the Amendment and Response filed on 30 March 2004 did not necessitate the new grounds of rejection since the claims amended merely incorporated *previously presented* dependent claims into the independent claims. The rendering of a Final Rejection is improper when the Examiner has applied a new ground of rejection. Withdrawal of the finality of the rejection is therefore requested.

Examiner's Refusal to Consider the Preamble is Improper. The Examiner indicates that the claimed preamble "doesn't constitute method assisting limitations because it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." (Paragraph 7 of Office Action.)

The Examiner, by failing to consider the Federal Circuit's more recent rulings, misconstrues the law. A preamble properly limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002)

(quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. See, e.g., *Electro Sci. Indus. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348, 64 USPQ2d 1781, 1783 (Fed. Cir. 2002); *Rapoport v. Dement*, 254 F.3d 1053, 1059, 59 USPQ2d 1215, 1219 (Fed. Cir. 2001); *Pitney Bowes*, 182 F.3d at 1306, 51 USPQ2d at 1166. The preamble in Applicants' claims breathes life and meaning into the claim and incorporates by reference language which appears later in the claim. Element (d) of Claim 23, as well as element (a) of Claim 37, only makes sense when read in light of the claim preamble. For instance, in Claim 37, the claimed "compromised barrier" in the preamble is the causative effect of the electrical box of step (a). See further, *Griffin v. Bertina*, 285 F.3d 1029, 62 USPQ2d 1431 (Fed. Cir. 2002) (preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise.).

Further, the Examiner's reliance on *In re Hirao*, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951) is misplaced. In *Hirao*, the Solicitor for the PTO argued that the preamble in a three-step process claim merely recited the purpose of the process and thus the third step did not depend on the preamble for completeness. The Court however *disagreed* with the PTO and stated that the "Solicitor's interpretation of the preamble would improperly *broaden* the scope of the claim" and that that the obviousness of an invention must be based on all of the steps, not just the last. (*Hirao* at 18).

Kropa is not germane to the claims of Applicants because the issue in *Kropa* was whether the phrase "an abrasive article" introduced a limitation into the counts. Thus, *Kropa*

dealt with the effect of a preamble on a *product* claim, not a process claim. In any event, the court in *Kropa* concluded that the preamble *did have* bearing on the count:

... where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over the prior art. ...

In the case before us, the words "An abrasive article" are essential to point out the invention defined by the counts. In our judgment those introductory words give life and meaning to the counts, for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an "abrasive article." The term calls forth a distinct relationship between the proportions of grain and resin comprising the article. It is important here, as it was in *Hall v. Shimadzu*, 19 C.C.P.A. (Patents) 1288, 59 F.2d 225, 13 USPQ 259, that the interference counts originated in one party's patent where the entire object of the patent is expressed in the introductory clause of the counts--an objective which nowhere appears in the other party's disclosure (here, appellant's 1938 applications). The term "abrasive article" is a vital term of the counts, and the meaning must be taken from the application in which the counts originated. *Kenyon v. Crane*, 28 C.C.P.A. (Patents) 1208, 120 F.2d 380, 49 USPQ 707. We hold that it is a limitation which is material to the issue, and must be observed. (*Kropa* at 481.)

Examiner's Rejection of Claims 23-27, 37-38 and 40 Under 35 U.S.C. § 102(e) Over *Dykhoff*.

The Examiner has maintained the rejection of Claims 23-27, 37-38 and 40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,521,834 ("*Dykhoff*"). This rejection is traversed.

The Examiner previously acknowledged that now canceled Claim 42 was not anticipated by *Dykhoff* (since the rejection in the last Office Action was not applied against Claim 42). The limitations of canceled Claim 42 were incorporated into both independent

claims of this application, Claim 23 and Claim 37. The Examiner's finality of the rejection over *Dykhoff* is therefore misplaced because this is the first Office Action rejecting the claims of *Dykhoff* directed to the claimed limitation that the fire resistant insulative material may contain mineral wool etc.

The Examiner states that the previously filed Declaration is insufficient to overcome the rejection and, in so doing, dissects each of the Exhibits attached to the Declaration. Under 37 CFR § 1.131, the Declaration need only "establish invention of the subject matter of the rejected claim prior to the effective date of the reference. . . ." Exhibit B to the Declaration clearly indicates the use of graphite as an intumescent material. Exhibit A clearly indicates the use of the gasket behind the cover plate of the outlet box. There is no requirement that the invention must be established from one sole piece of evidence. All of the evidence submitted was dated prior to August 25, 2000 as stated by the declarant.

In any event, Applicants' claims have been amended to specifically recite only the fire resistant insulative material as intumescent graphite or mineral wool. Neither of these materials is disclosed in *Dykhoff*. *Dykhoff* therefore cannot anticipate the claimed invention of Applicants.

Examiner's Rejection of Claims 23-27, 37-38 and 40 Under 35 U.S.C. § 103(a). The Examiner has further rejected Claims 23-27, 37-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,293,173 ("*Tricca*") in view of *Landin*. This rejection is traversed.

The Examiner states that *Tricca* discloses "at least partially reestablishing a fire rating of the barrier," relying upon col. 1, ll. 65-68, col. 2, ll. 1-3, col. 3, ll. 53-56 and col. 4, ll. 9-15. None of these passages relate to the claimed limitation of Applicants. *Tricca* discloses a thermal insulation system for an electrical outlet. As set forth in col. 1, ll. 65-68 and col. 2, ll.

1-3, the thermal insulation system of *Tricca* diminishes "heat conduction through the outlet, [providing] a barrier against moisture permeation into the wall insulation." This does *not* translate to use of a gasket to reestablish a fire rating. Neither does *Tricca* disclose the use of the thermal insulation system to assist a compromised barrier. The thermal insulation system of *Tricca* is used to safeguard against moisture permeation and to prevent air infiltration through the outlet. It is for these reasons that *Tricca* uses a material of "low thermal conductivity and good compressibility and resilience" such as a closed cell nitrile-PVC blend foam, like Armaflex® foam. Such materials are not mineral wool or intumescent graphite.

The Examiner relies upon *Landin* to cure the deficiencies of *Tricca*. *Landin* merely discloses intumescent materials such as graphite. There is no reason to conclude that substitution of the materials disclosed in Applicants' specification into *Tricca* would render an effective method of assisting a compromised barrier. In fact, it is unclear why one of skill in the art would substitute such intumescent materials for the resilient and compressible closed cell nitrile PVC blend foams of *Tricca*. This is especially true since the foams of *Tricca* are being used to prevent air infiltration through the outlet and as a barrier against moisture permeation into the wall insulation. This is not the objective of the intumescent materials of *Landin*.

In any event, *Tricca* fails to disclose the methodology that is the crux of the invention. The compromised barrier of Applicants' claims has a certain fire rating from one area on one side of the barrier to another area on another side of the barrier. The present invention is concerned with a method of correcting the defect (loss of fire rating) in the compromised barrier. There is no reason why one of skill in the art would have been motivated to substitute the materials in *Landin* for the thermal insulating material in *Tricca*, especially since *Tricca*

does not disclose the use of such thermal insulating materials to assist compromised barriers, such as in the reestablishment of fire ratings.

Examiner's Rejection of the Claims Under the Second Paragraph of 35 U.S.C. § 112. The Examiner has rejected Claim 23-27 under the second paragraph of 35 U.S.C. § 112. The Examiner contends that the phrase "at least partially reestablishing a fire rating of the barrier" is confusing since it is unclear "because what is a time limit or periods of time for at least partially reestablishing a fire rating of the barrier?" (Third paragraph of Office Action.)

The Examiner's rationale is not understood. The claims state that the process is capable of "at least partially reestablishing a fire rating of the barrier," i.e., partially or fully reestablishing a fire rating of 1, 2, 3, or 4 hours. One of skill in the art would recognize that barriers typically exhibit maximum fire ratings of 1, 2, 3 or 4 hours. A 4-hour maximum rated barrier having gaskets rated for 2 hours would only be capable of partially reestablishing the fire rated barrier (for 2 hours). A 2-hour maximum rated barrier having gaskets rated for 2 hours would be capable of completely reestablishing its fire rating. Thus, the claimed terminology of "at least partially reestablishing a fire rating of the barrier" is not indefinite to those of skill in the art.

The Examiner takes the view that the period of time must be quantified. However, the proper inquiry as to whether a claim is definite under the second paragraph 35 USC § 112 is whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). The Examiner has provided no support as to why those of skill in the art would not understand the terminology employed in the claims of Applicants.

Further, Applicants respectfully assert that the claims clearly set forth the area over which Applicants seek exclusive rights. This is the criterion of the second paragraph of 35 U.S.C. § 112. As set forth by the C.C.P.A. in *In re Borkowski*, 164 U.S.P.Q. 642, 645-646 (C.C.P.A. 1970):

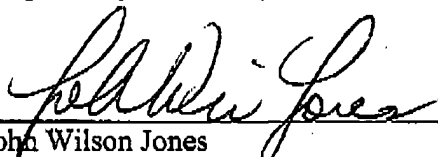
The first sentence of the second paragraph of § 112 is essentially a requirement for precision and definiteness of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends the claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. (Emphasis in original.)

Applicants have succinctly claimed the metes and bounds of their invention and thus the rejection should be withdrawn. See further *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) ("[T]he definiteness of the language employed must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.") and *In re Mercier*, 185 USPQ 774, 780 (CCPA 1975) ("The purpose of the second paragraph is to ensure that those skilled in the art can determine with precision the metes and bounds of the claims."). Reconsideration is therefore respectfully requested.

Conclusion. The Examiner is respectfully requested to telephone the undersigned should he deem it prudent to expedite the prosecution of this application into a Notice of Allowance.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.6(d)

I hereby certify this correspondence is being transmitted, on the date indicated below to the United States Patent and Trademark Office, via facsimile 703-872-9306.

Date: September 7, 2004


John Wilson Jones